

### **REMARKS**

The paper is in response to the Office Action mailed December 18, 2009 ("the Office Action"). The foregoing amendment cancels claim 2; amends claims 1 and 35, and adds no new claims. Claims 1, 3-14, and 33-41 are now pending in view of the amendments. Applicants respectfully request reconsideration of the application in view of the above amendments to the claims and the following remarks. For Examiner's convenience and reference, Applicants present remarks in the order that the Office Action raises the corresponding issues.

In connection with the prosecution of this case and any related cases, Applicants have, and/or may, discuss various aspects of the disclosure of the cited references as those references are then understood by the Applicants. Because such discussion could reflect an incomplete or incorrect understanding of one or more of the references, the position of the Applicants with respect to a reference is not necessarily fixed or irrevocable. Applicants thus hereby reserve the right, both during and after prosecution of this case, to modify the views expressed with regard to any reference.

Please note that Applicants do not intend the following remarks to be an exhaustive enumeration of the distinctions between any cited references and the claims. Rather, Applicants present the distinctions below solely by way of example to illustrate some of the differences between the claims and the cited references. Finally, Applicants request that Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of any reference is consistent with Examiner's understanding.

Unless otherwise explicitly stated, the term "Applicants" is used herein generically and may refer to a single inventor, a set of inventors, an appropriate assignee, or any other entity or person with authority to prosecute this application.

### **Rejection Under 35 U.S.C. §101**

The Office Action has rejected claims 1-14 and 33-41 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. In response, Applicants have amended independent claims 1 and 35 to recite that at least one step of the method is performed by a multi-protocol communications analyzer, which is a machine as is clearly discussed in the

pending application at Figures 2 and 3, for example. Accordingly, the claims now are tied to a particular machine and thus meet the *Bilski* test. Applicants respectfully request that this rejection be withdrawn.

### **Rejection under 35 U.S.C §103(a)**

The Office action rejects dependent claim 2 under 35 U.S.C §103(a) over *Oyadomari* (U.S. Patent Publication No. 2005/0060402)<sup>1</sup> in view of *Seawright et al.* (U.S. Patent No. 5,920,711).

Applicants traverse the Examiner's rejection for obviousness because *Oyadomari* qualifies as prior art only under subsection (e) of 35 U.S.C 102 and the subject matter of *Oyadomari* was owned by the same person or subject to an obligation of assignment to the same person at the time of the Applicants invention. For example, the publication date of *Oyadomari* is March 17, 2005, with a priority date of September 10, 2002, while the earliest priority date of the pending application is January 24, 2003, thus making *Oyadomari* qualify as prior art only under subsection (e) of 35 U.S.C 102. Further, both *Oyadomari* and the pending application were owned by Finisar Corporation or subject to an obligation of assignment to Finisar Corporation at the time of the Applicants invention. Applicants' attorney hereby makes of record a statement to the effect that the present application and *Oyadomari* were, at the time the present invention was made, owned by, or subject to, an obligation of assignment to the same entity. Therefore, under 35 U.S.C. § 103(c) *Oyadomari* does not preclude patentability of claim 2 of this application.

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<sup>1</sup> Because *Oyadomari* is only citable under 35 U.S.C. § 102(e) Applicants do not admit that *Oyadomari* is in fact prior art to the claimed invention but reserve the right to swear behind *Oyadomari* if necessary to remove it as a reference.

### **Rejection Under 35 U.S.C. §102**

The Office Action rejects claims 1, 3-14, and 33-41 under 35 U.S.C. §102(e) over *Oyadomari et al.* Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *MPEP § 2131*. Applicant respectfully submits that the *Oyadomari* reference does not teach each and every element of any of the pending claims for at least the reasons that will now be explained.

As shown above, Applicant has amended claim 1 to recite among other limitations the limitations of formerly pending claim 2, including "wherein at least a portion of the method is performed by way of a graphical user interface." (Emphasis added). As admitted by the Examiner in relation to the rejection of formerly pending dependent claim 2, *Oyadomari* does not teach or suggest a graphical user interface as recited in amended claim 1. Accordingly, *Oyadomari* does not teach or suggest each and every element of amended claim 1.

As noted in the Office Action in relation to the rejection of formerly dependent claim 2, the Examiner alleges that *Seawright et al.* teaches "wherein at least a portion of the method is performed by way of a graphical user interface." However, assuming *arguendo* that this is true, as shown above, *Oyadomari* cannot be combined with *Seawright* to reject the claims of this application as *Oyadomari* does not qualify as prior art for the pending application when combined with another reference.

Accordingly, inasmuch as the Office Action has not established that *Oyadomari* teaches each and every element of amended claim 1, that the identical invention is taught or suggested in *Oyadomari* in as complete detail as is contained in claim 1 and because the Office Action has not shown that *Oyadomari* discloses the elements of claim 1 arranged as required by those claims, Applicant respectfully submits that the Office Action has not established that *Oyadomari* anticipates claim 1. For at least the foregoing reasons, Applicant respectfully submits that the anticipation rejection of claim 1 as well as the rejection of corresponding dependent claims 3 - 14, and 33 - 34 should be withdrawn.

Applicants note that as shown above, independent claim 35 has been amended to recite the elements of formerly pending claim 2. As admitted by the Examiner in relation to the rejection of formerly pending dependent claim 2, *Oyadomari* does not teach or suggest a graphical user interface as recited in amended claim 35. Accordingly, *Oyadomari* does not teach or suggest each and every element of amended claim 35.

As discussed above, *Oyadomari* cannot be combined with *Seawright* to reject the claims of this application as *Oyadomari* does not qualify as prior art for the pending application when combined with another reference.

Accordingly, inasmuch as the Office Action has not established that *Oyadomari* teaches each and every element of amended claim 35, that the identical invention is taught or suggested in *Oyadomari* in as complete detail as is contained in claim 35 and because the Office Action has not shown that *Oyadomari* discloses the elements of claim 35 arranged as required by those claims, Applicant respectfully submits that the Office Action has not established that *Oyadomari* anticipates claim 35. For at least the foregoing reasons, Applicant respectfully submits that the anticipation rejection of claim 1 as well as the rejection of corresponding dependent claims 36 – 41 should be withdrawn.

### **Charge Authorization**

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

### **CONCLUSION**

In view of the foregoing, Applicants believe the claims as amended or presently pending are in allowable form and that every issue raised by the Office Action has been addressed. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorneys.

Dated this 29<sup>th</sup> day of April, 2010.

Respectfully submitted,

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